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08/802,472

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CHARLES KORMANIK JR.

thematic

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KAJANE MCMANUS

P.O.BOX 490

WONDER LAKE, IL 60097

EXAMINER

GERRITY, STEPHEN FRANCIS

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3721

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 08/802,472	Applicant(s) KORMANIK, CHARLES	
	Examiner Stephen F. Gerrity	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,8-15,17-30 and 32-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,8-15,17-30 and 32-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/8/04 & 8/6/99 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5, 8-15, 17-24 and 27-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as per the Decision of the Board of Appeals of 17 August 2006.

As was stated in the Board decision (pp. 21-25):

"More particularly, we point to the claimed characterization of an icon as **"recognizable"**, and of the claimed characterization of the shape of the package as **"visually suggestive"** of an activity **"associated with"** the icon in which the article is used during the activity. The characterization of "recognizable", "visually suggestive", and "associated with" are totally subjective to each individual obviating any possibility of pointing out the scope of the claims with any degree of particularity.

Our reviewing court has held that

Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the claimed invention.

Datamize, LLC v. Plumtree Software, Inc., 417 F. 3d 1342; 75 U.S.P.Q.2D 1801 (Fed. Cir. 2005). These noted characterizations in these claims so rejected have no objective standards and therefore fail to provide the direction required under 35 U.S.C.

Art Unit: 3721

§ 112, second paragraph, to one skilled in the art attempting to determine the scope of the claimed invention.

Analysis.

We first look to the intrinsic record to determine whether there is any objective standard for these claim terms. The specification states that

It has been discovered that packaging can and should have independent utility from merely containing. The **shape of the packaging** can be useful, for example, in **communicating what is in the packaging and/or how to use the contents of the packaging** The process for making structural indicia packaging can therefore be described as having the steps of selecting a symbol or icon having a shape that **suggests** an activity ... (emphasis added) [See Specification at p. 3-4]

And

What is important is to pick a symbol or icon suitable for thematically-shaped packaging for a subsequently used article. [See Specification at p. 13]

And

There can be any item or article having a use suggested by the shape of the packaging... [See Specification at p. 15]

The specification then provides a golf ball as an example of the shape and rain apparel, insect repellent and bee sting treatment as an example of the contents. Perhaps most informative of the objectivity, or lack thereof, of any standard for the suggestive power of the icon is the specification's description of the inclusion of the raingear.

For a more specific example, packaging shaped like a golf ball suggests that the content of the packaging is useful in connection with the game of golf, i.e. light weight rain apparel or gear packaged in the golf ball for use in playing golf in the rain.

As to prosecution history, there appears to be no discussion regarding the standard for determining recognizability of an icon, but the appellant has generally relied on an inconceivability standard regarding the "visually suggestive of an activity associated with ... in which the article is used" criterion, e.g. "nor can one imagine" [see Brief at p. 18] and "no one could conceivably think of..." [see Applicant's Amendment and Response filed 10/21/2002].

The specification thus relies on circular logic as the standard for both recognizability and being visually suggestive, as it teaches that the shape of the icon is to suggest what is inside and what is inside is taught as something suggested by the shape of the package. Thus there is no objective standard for either recognizability or being visually suggestive taught in the specification. We note that the example of raingear is of little assistance in forming a standard, for raingear is needed for any activity in the rain, a far broader category of activity than a single sport or theme. We can think of no way in which, absent foreknowledge of the contents and a conscious personal mental linkage made between the contents and the package, such linkage being personal and thus independent of any visual suggestive power of the icon, anyone would find a sports play piece icon suggestive of rain gear.

We further note that the example of golf in the specification introduces the linkage of an activity of playing golf between the icon and the contents, i.e. the icon of a golf ball suggests playing golf which in turn suggests the need for rain gear. [See Specification at p. 4] But raingear is not among the component parts suggested by the rules of golf, nor is it a uniform or some ubiquitous manifestation, such as a golf cart, of

Art Unit: 3721

golf. Hence its visual suggestion is only by virtue of what the particular person making the mental leap from icon to activity to article has by way of personal memory towards that suggestion. Hence there is no objective test disclosed for the scope of the activities that an icon might suggest, nor of the level of the icon's ability to visually suggest an article that might be used during any such activity. Indeed, the test the appellant has applied in the prosecution history, that of inconceivability, is highly subjective to the personal levels of conception.

As the opinion in *Datamize* (where the subjective element was the phrase "aesthetically pleasing") stated

The scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention. See *Application of Musgrave*, 431 F.2d 882, 893 (C.C.P.A. 1970) (noting that "[a] step requiring the exercise of subjective judgment without restriction might be objectionable as rendering a claim indefinite"). Some objective standard must be provided in order to allow the public to determine the scope of the claimed invention. Even if the relevant perspective is that of the system creator, the identity of who makes aesthetic choices fails to provide any direction regarding the relevant question of how to determine whether that person succeeded in creating an "aesthetically pleasing" look and feel for interface screens. A purely subjective construction of "aesthetically pleasing" would not notify the public of the patentee's right to exclude since the meaning of the claim language would depend on the unpredictable vagaries of any one person's opinion of the aesthetics of interface screens. While beauty is in the eye of the beholder, a claim term, to be definite, requires an objective anchor. *Id.* at 1350

And

Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the claimed invention. In short, the definition of "aesthetically pleasing" cannot depend on the undefined views of unnamed persons, even if they are experts, specialists, or academics. *Id.* at 1352

We note that the standards of recognizability and visual suggestion are no more objective than a standard for aesthetic pleasure. All three are highly dependent on geographic, cultural, and personal history vagaries of the people to whom such criteria apply. An icon of a cricket bat might be immediately recognizable in British areas, but would more likely be thought to be a fraternity pledge paddle in the United States. Certainly the activities suggested by each would be very different indeed. A more domestic example would be a sphere with a small circle drawn on top. While most domestic observers might scratch their heads over what this represented, many from the American South would recognize it as an iconic black-eyed pea."

Therefore, because as the court stated in *Datamize*, the definition of a claim limitation cannot depend on the undefined views of unnamed persons, claims 5, 8-15, 17-24, 27-58 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

3. Claims 21, 22 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21, 22 and 28-30 are indefinite in that it is unclear what is being claimed. All the claims recite the package separately from the articles. The independent claims on which the above claims depend recite only a step of "constructing...a package" and none of the claims recite a step of "constructing the article" as the above dependent

Art Unit: 3721

claims do. Therefore, there is no proper antecedence for the later step in the independent claims.

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Rejections based on Kirkland (6,006,945)

6. Claims 5, 17, 21, 22, 34, 35, 37, 39, 40, 42-51, 55 and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Kirkland (6,006,945).

The patent to Kirkland discloses a method for making a combination of a package and article that comprises constructing a plastic package having a recognizable shape that is different from the article to be placed in it, the package comprises of totally separable parts (see column 4, line 23 et seq. and the figures), locating an article within the package and marketing the combination. Examples of articles that can be placed in the package include balls, clothing, cleaning items and

Art Unit: 3721

personal hygiene products (see column 5, line 44 et seq). The step of folding the article is inherent in the Kirkland process and is read on the step of reducing a piece of clothing to the size of the package.

Regarding claims 21 and 22, articles like clothing comprise one or two flaps that form openings, e.g. sleeves or hosiery.

Regarding claims 35, 40, 42 and 51, Kirkland discloses the method of using more than one combination of a package and article since the patent discloses the packing of different articles in the different packages.

Regarding claims 45, 46 and 48, the claimed lips are read on the edge portions of the separable parts of the package of Kirkland.

Regarding claim 58, Kirkland discloses the article being a first aid item.

7. Claims 27/5-29/5, 30, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkland (6,006,945).

Since Kirkland teaches the placing of clothing within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package. In fact the placement of any article in the package of Kirkland, including articles with openeable lips such as bags (claim 29), would have been obvious to one skilled in the art. The claims would have been obvious because the substitution of one known article for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention.

Rejections based on Kaufman (5,813,538)

8. Claims 5, 17, 18, 21, 22, 34, 35, 37, 39, 40, 42-51 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaufman (5,813,538).

The patent to Kaufman discloses a method for making a combination of a package and article that comprises constructing a plastic package having a recognizable shape that is different from the article to be placed in it, the package comprises of totally separable parts (see the figures), locating an article within the package and marketing the combination. Examples of articles that can be placed in the package include t-shirts, towels etc (see column 1, line 17 et seq). The step of folding the article is inherent in the Kaufman process and is read on the step of reducing a piece of clothing to the size of the package.

Regarding claim 18, Kaufman discloses in column 5, line 43 et seq that combining of two packages in one outer package.

Regarding claims 21 and 22, articles like clothing comprise one or two flaps that form openings, e.g. sleeves.

Regarding claims 35, 40, 42 and 51 and their dependent claims, Kaufman discloses the method of using more than one combination of a package and article since the patent discloses the packing of different articles in the different packages.

Regarding claims 45, 46 and 48, the claimed lips are read on the edge portions of the separable parts of the package of Kaufman.

9. Claims 19, 20, 23, 27/5-29/5, 30, 38, 41 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman (5,813,538) in view of Applicant's Admitted Prior Art.

In the previous Office action the examiner took Official Notice that combining of two packages containing different articles in one outer package is well known in the art. Applicant has failed to adequately traverse the examiner's position of Official Notice and thus accordingly the particular limitations of claims 19, 20 and 23 are deemed to be applicant's admitted prior art (see MPEP 2144.03). Therefore, regarding claims 19, 20 and 23, combining of two packages containing different articles in one outer package is well known in the art; packing two different articles are well known in kit form to provide the consumer with one pack; and similarly, the use of a means for attaching a package to another article (claim 23) is well known in the art, and it would have been obvious to one skilled in the art to have modified the Kaufman method by having combined two packages containing different articles in one outer package, to have modified the Kaufman method by having packaged two different articles, and to have modified the Kaufman method by having provided means for attaching a package to another article.

Regarding the other claims, Kaufman teaches the placing of clothing within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package. In fact the placement of any article in the package of Kaufman, including articles with openable lips such as bags (claim 29), would have been obvious to one skilled in the art. The claims would have been obvious because the substitution of one known article for another would have yielded

Art Unit: 3721

predictable and expected results to one of ordinary skill in the art at the time of the invention.

10. Claims 8-15, 24-26, 27/8+, 28/8+, 29/8+, 36 and 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Kaufman (5,813,538) in view of Gossard (3,624,939).

The patent to Kaufman shows various embodiments and shapes of packages having separable parts but it doesn't show package shaped as balls. The patent to Gossard shows packages of various shaped in the form of baseball, football, basketball and soccer ball. It would have been obvious to one skilled in the art to shape the packages of Kaufman in any desired shape including balls as shown by Gossard. The modification of Kaufman by forming the package with a ball shape as shown by Gossard would have been obvious because the use of one known and equivalent package shape for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention. Since Kaufman teaches the placing of clothing within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package.

Rejections based on Forrest (1,800,990) and Francis (D346185)

11. Claims 32-35, 40, 42 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by the patent to Forrest (1,800,990) or Francis (D346185).

Each of these patents discloses a method for making a combination of a package and article that comprises constructing a package as a replica of a recognizable icon having a shape that is different from the article to be placed in it with the package shape

conveying information relative a sport, the and locating an article within the package. Both packages and articles are used in environments which the shape of the package indicates.

Rejections based on Servick (5,450,979)

12. Claims 32-35, 37, 40, 42-51 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Servick (5,450,979).

The patent to Servick discloses a method for making a combination of a package and article that comprises constructing a package having the shape of a football and which is different from the article to be placed in it, the package comprises of totally separable parts (see the figures). Examples of articles that can be placed in the package include toys, wallet, keys, coins, candy bars, chips etc (see column 3, line 23 et seq).

Regarding claims 35, 40, 42 and 51 and their dependent claims, Servick discloses the method of using more than one combination of a package and article since the patent discloses the packing of different articles in the different packages.

13. Claims 26, 38, 41, 54, 56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Servick (5,450,979).

The package of Servick lacks the specific article recited in claim 26. Since Servick teaches the placing of different kinds of articles within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package. In fact the placement of any article in the package of Servick, including articles with openable lips such as bags, would have been obvious to one

skilled in the art. The claims would have been obvious because the substitution of one known article for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention.

14. Claims 24, 25, 36, 52, 53 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Servick (5,450,979) in view of Gossard (3,624,939).

The package of Servick lacks the shape of a golf ball. The patent to Gossard shows packages of various shaped in the form of baseball, football, basketball and soccer ball. It would have been obvious to one skilled in the art to shape the packages of Servick in any desired shape including balls as shown by Gossard. The modification of Servick by forming the package with a ball shape as shown by Gossard would have been obvious because the use of one known and equivalent package shape for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention.

Response to Arguments

15. Applicant's arguments filed 3 April 2008 have been fully considered but they are not persuasive.

Applicant argues that the amendments to the claims overcomes the 35 USC 112, second paragraph rejections made in the previous Office action. This argument is unpersuasive as the amendments in fact do nothing to overcome the rejection.

Applicant's arguments concerning the rejections using the Kirkland patent are noted, but deemed unpersuasive. The previous Office action properly rejected the claims mentioned therein as anticipated under 35 USC 102. The Kirkland reference has

Art Unit: 3721

an earlier filing date than the present application and thus is properly prior art under 102(e). Applicant's comments regarding "generic" and "iconic" are noted but have no bearing on the rejection because the subject matter of the claims is properly broadly interpreted because "recognizable icon" is so overly broad that it is indefinite. A "recognizable icon" is a subjective term and thus a person of ordinary skill in the art could interpret anything to be a "recognizable icon".

Applicant's arguments concerning the rejections using the Kaufman patent noted, but deem unpersuasive. Once again applicant argues that Kaufman lacks a thematic icon, but such is clearly erroneous as the object in Kaufman is a recognizable icon. The argument that applicant cannot find the method claimed in the Kaufman patent and that folding is not disclosed by Kaufman is noted but disagreed with by the examiner. As stated above the folding (which is a broad term) occurs in Kaufman during the compression of the article. No specific or particular type of folding is claimed. Furthermore, the examiner as stated above has shown the method steps set forth in the claims. Regarding the combination of Kaufman and Gossard, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The rejection is not based on literal or bodily incorporation rather the rejection is based on what the references would have suggested to a person having ordinary skill in the art.

Applicant's arguments concerning the rejections using the Forrest or Francis patents is noted but unpersuasive. Applicant fails to address the rejection other than to argue that the combination proposed by the examiner escapes the applicant and that the claimed method is not found in the patents. There is no combination in the rejections. The rejections are based on 102 anticipation. Furthermore, the references teach and disclose the claimed method to a person having ordinary skill in the art.

Applicant's arguments concerning the rejections using the Servick patent are similar to those above. The examiner points out that the reference teaches and discloses the claimed method to a person having ordinary skill in the art.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached form (PTO-892) are cited to show packages and methods of packaging articles. All are cited as being of interest and to show the state of the prior art.

17. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is 571-272-4460. The examiner can normally be reached on Monday - Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen F. Gerrity/
Primary Examiner
Art Unit 3721

31 July 2008